REMARKS

Claims 1-105 are pending in this application. Claims 1-3, 36-38 and 71-73 have been elected in response to a restriction requirement. Accordingly, claims 4-35, 39-70 and 74-105 are withdrawn and hereby canceled without prejudice. Claims 1-3, 36-38 and 71-73 have been rejected under 37 C.F.R. §103(a). Claims 1, 36, 37, 38 and 71 have been amended in this response.

Drawings

The Office objected to the drawings that were filed on December 27, 2000. Accordingly, applicants herewith provide seven (7) replacement sheets for the drawings.

Rejections under 35 U.S.C. §103(a)

Claims 1-3, 36-38 and 71-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,621,805 issued to Loh et al. on April 15, 1997 (hereinafter "Loh").

Independent Claims 1, 36 and 71

With respect to independent claims 1, 36 and 71, the Office states that:

> Loh does not explicitly disclose that the digital volume control blocks determine a scale factor for each of said digital audio files. However, in Loh's disclosure of a prior art analog audio mixer (fig. 2), the art teaches where the amplitude of each analog input signal is selectively adjusted depending on a volume control selection.

Office Action, page 3.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. MPEP § 2143.

With respect to the third criterion listed above (the prior art reference must teach or suggest all of the claim limitations), Loh does not disclose, teach or suggest determining a scale factor for each of the digital audio files according to the present invention. In contrast, Loh states that "the amplitude of each analog input signal is selectively adjusted depending on a volume control selection." Loh does not expand on what volume control selection entails and it is improper to equivocate or read into Loh the determining of a scale factor. Generally, in analog mixers, volume control selection includes manual adjustment of the volume of each channel. In such systems, there is no determination or calculation of a *scale factor* according to the present invention. The user simply adjusts the volume by ear. The volume is not adjusted in calculated amounts; that is, the user does not, for example, measure peak values, calculate root-mean-square values or use constant mixing factors to arrive at a scale factor which is then applied to control the volume of each channel. Nor is there anything in Loh's digital audio mixer that discloses, teaches or suggests how the volume is digitally scaled. For these reasons, the independent claims are nonobvious.

To further clarify the invention, applicants have amended independent claims 1, 36 and 71. The amended independent claims now recite the following additional limitations:

1. The scale factor is determined *automatically*.

2. The scale factor for each of the digital audio files is determined *based on an analysis of the at least two digital audio files*.

3. The analysis of the at least two digital audio files is performed *by a digital processing unit*.

4. The scale factor is applied to each of the digital audio files *to create scaled digital audio files*.

5. The *scaled* digital audio files are combined.

Applicants believe that these amendments further clarify the invention as claimed and further differentiate the invention from Loh. Loh does not disclose, teach or suggest at least one of the above limitations. For example, the prior art does not disclose, teach or suggest that the scale factor is determined based on an analysis of the at least two digital audio files. Nor does the prior art disclose, teach or suggest that the scale factor is determined automatically or by a digital processing unit. Because Loh does not disclose, teach or suggest at least one of the limitations of as-amended claims 1, 36 and 71, these independent claims and their respective dependent claims are not obvious and in a condition for allowance.

Furthermore, with respect to the first criteria for establishing a case for obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. There is no suggestion or motivation in Loh or in the knowledge available to one of ordinary skill in the art to modify Loh such that (1) a scale factor is determined, (2) automatically, (3) by a processing unit, and (4) based on at least two of the digital audio files. For these reasons, the first criterion for establishing a prima facie case of obviousness is not met. Therefore, the as-amended independent claims and their respective dependent claims are in a condition for allowance.

Dependent claims 2, 37 and 72

Dependent claims 2 and 72 recite that the "method is performed within a server device operatively coupled over a network to a client device" and dependent claim 37 recites that "the apparatus is a server device operatively coupled over a network to a client device." The Office states that:

> Loh does not disclose the computer system as a server device operatively coupled over a network device to a client. However, Examiner takes official notice that it would have been obvious at the time of the invention to use Loh's computer as a server coupled to other client devices over a network. It is notoriously well known to connect a computer to a network and use it as a server.

Office Action at page 3.

Applicants traverse this rejection made by the Office with respect to dependent claims 2, 37 and 72 and request that the Office provide a prior art reference or other documentary evidence to support its assertion of official notice. MPEP §2144.03. Applicants contend that official notice cannot be taken with respect to using Loh's computer as a server coupled to other client devices over a network. Official notice with respect to generally using computers over a network is different from using a digital audio mixer or Loh's computer over a network coupled as server-to-client. There must be some form of evidence in the record to support an assertion of common knowledge. MPEP §2144.03.

Because the Office's assertion of official notice is traversed by the applicants, with respect to the third criteria listed above for establishing a prima facie case of obviousness, Loh does not disclose, teach or suggest all of the claim limitations found in dependent claims. In particular, Loh does not disclose, teach or suggest a server device operatively coupled over a network to a client device as in claims 2 and 72. Also, Loh does not disclose, teach or suggest the limitation of the apparatus being a server device operatively coupled over a network to a client device as in claim 37. Because Loh does not teach or suggest all of the claim limitations in claims 2, 37 and 72, a prima facie case of obviousness is not established.

Furthermore, applicants maintain that the first criterion for establishing a prima facie case of obviousness is not satisfied as well. This criterion requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Applicants maintain that there is no suggestion or motivation, either in Loh or in the knowledge generally available to one of ordinary skill in the art to modify Loh or to combine Loh with assertions of official notice made by the Office. In particular, there is no suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art to modify Loh such that the digital mixer of Loh is provided over a network to a client device. In fact, Loh *teaches away* from modifying Loh in such a manner or combining Loh with the assertion of official

notice taken by the Office for several reasons. In particular, in the area of audio mixing, a user generally wishes to maintain control over each of the channel volumes in order to determine for him/herself the balance for the final mix. Loh even provides "a plurality of individual volume controls for individually adjusting the volume on each channel." Loh, col. 6, lines 11-14.
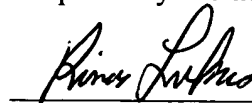
In contrast, in the present invention, the user surrenders control over each of the channel volumes to the automatic mixing system. The automatic mixing system of the present invention takes the decision regarding the final mix away from the user. In the prior art analog mixer disclosed in Loh, the volume is "selectively adjusted." Loh is silent as to how the volume is to be "selectively adjusted" over a network by the user. Loh is also silent as to how the server device would "automatically" determine a scale factor as now claimed. As a result, there is no reasonable expectation of success that Loh would function as modified in the absence of such disclosures, suggestions and motivations. For these reasons, a prima facie case is not established because of failure to satisfy the first and second criteria. Therefore, the claims are nonobvious and in a condition for allowance.

Therefore, for the reasons described above, the rejection under 35 U.S.C. §103(a) should be withdrawn with respect to claims 1-3, 36-38 and 71-73. In view of the foregoing remarks, applicants respectfully submit that the application is in a condition for allowance, and action toward that end is earnestly solicited. In the event that a telephone conference would expedite prosecution of this patent application, the Examiner is invited to contact the Attorney for Applicants at the number listed below.

Respectfully submitted,

Dated: August 3, 2005   By: _____

Rimas T. Lukas
Registration No. 46,451

Lukas IP Group
2707 18th Street
San Francisco, California 94110
Telephone: (415) 641-7500
Facsimile: (650) 897-9944